

BS01042

U.S. Application No. 10/017,428 Art Unit 2623
Submission of Amendment with RCE in Response to April 19, 2006 Final Office Action

REMARKS

In response to the final Office Action dated April 19, 2006, the Assignee respectfully requests continued examination and reconsideration based on the above claim amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited documents to *Nakai*, *Hylton*, *Rowe* and *D'Luna*.

Claims 1-16 are currently pending in this application.

The United States Patent and Trademark Office (the "Office") rejected claims 1 and 12 under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. Claims 1, 2, and 11 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,654,901 to *Nakai et al.* Claims 3-4 and 12-15 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Nakai* in view of U.S. Patent 5,708,961 to *Hylton et al.* Claims 5-8 and 16 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Nakai* in view of *Hylton* and further in view of Published U.S. Patent Application 2005/0060759 to Rowe. Claim 9 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Nakai* in view of *Hylton*, in view of *Rowe*, and further in view of U.S. Patent 5,793,413 to *Hylton et al.* Claim 10 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Nakai* in view of Published U.S. Patent Application 2002/0106018 to *D'Luna et al.*

The Assignee shows, however, that the pending claims are neither anticipated nor obviated by the cited documents. The Assignee thus respectfully submits that the pending claims distinguish over the cited documents.

Rejection under 35 U.S.C. § 112

The United States Patent and Trademark Office (the "Office") rejected claims 1 and 12 under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. Claims 1 and 12, however, have been amended and do not resemble their examined form. The rejection is thus moot.

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Rejections under 35 U.S.C. § 102

The Office rejects claims 1, 2, and 11 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,654,901 to Nakai *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P.").

Claims 1-2 and 11 are not anticipated. These claims recite, or incorporate, features that are not disclosed by Nakai. These claims all describe a media server having "*a broadband input/output module receiving the transport layer from the system bus and sending the transport layer to a network bus.*" A "*network input/output module receiv[es] the transport layer from the network bus.*" A "*decryption module ... receives the transport layer from the network input/output module and ... decrypts the transport layer.*" A "*demultiplexer ... receives the decrypted transport layer and ... demultiplexes the decrypted transport layer.*" A "*decoder ... decodes the demultiplexed and decrypted transport layer.*" Support for these features may be found at least at FIG. 7 and at page 24, line 19 through page 25, line 25 of the as-filed application. A "clean" version of independent claim 1 is reproduced below, and claims 2 and 11 depend therefrom.

1. A digital residential entertainment system, comprising:

a media server tuning to a transport layer and transmitting the entire transport layer, rather than a single program stream, over a system bus;

a broadband input/output module receiving the transport layer from the system bus and sending the transport layer to a network bus;

a network input/output module receiving the transport layer from the network bus;

a decryption module that receives the transport layer from the network input/output module and that decrypts the transport layer;

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a demultiplexer that receives the decrypted transport layer and that
demultiplexes the decrypted transport layer; and
a decoder that decodes the demultiplexed and decrypted transport layer.

Nakai does not anticipate these features. *Nakai* is completely silent to “a broadband input/output module receiving the transport layer from the system bus and sending the transport layer to a network bus.” *Nakai* is further silent to a “network input/output module receiving the transport layer from the network bus.” *Nakai*, then, cannot anticipate independent claims 1 and dependent claims 2 and 11, so the Assignee respectfully requests removal of the § 102 (e) rejection.

Rejection of Claims under 35 U.S.C. § 103 (a)

The pending claims are, likewise, not obvious. The Office rejects claims 3-10 and 12-16 under 35 U.S.C. § 103 (a) as being unpatentable over *Nakai* in view of various combinations of *Hylton '961*, *Rowe*, *Hylton '413*, and *D'Luna*. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires “some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill”; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter “M.P.E.P.”).

1. Because No “Teaching, Suggestion, or Motivation” was Cited, the § 103 (a) *Prima Facie* Case for Obviousness Is Improper

The Examiner has failed to properly make a *prima facie* case for obviousness. The Examiner’s *prima facie* case for obviousness must include “some teaching, suggestion, or motivation” to combine prior art that is found “either in the references themselves or in the knowledge generally available to one of ordinary skill.” DEPARTMENT OF COMMERCE,

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Here the Examiner's *prima facie* case fails to include any teaching, suggestion, or motivation. The Examiner fails to cite any passage from the cited documents. The Examiner cites no passage from the cited documents to support the *prima facie* burden. The Examiner also fails to assert anything found in the knowledge generally available to one of ordinary skill. The *prima facie* cases for obviousness, then, are at least improper for failing to provide any teaching, suggestion, or motivation to combine, as M.P.E.P. § 2143 requires. The Assignee thus respectfully asserts that the § 103 (a) rejection of the claims should be removed.

2. Because No Reasonable Expectation of Success was Cited, the § 103 (a) *Prima Facie* Case for Obviousness Is Improper

The Examiner's *prima facie* cases for obviousness are defective for another reason. The Examiner's *prima facie* cases for obviousness must include "a reasonable expectation of success." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition). Here, however, the Examiner's *prima facie* cases wholly fail to include any expectation of success. The Examiner, then, has failed to carry the burden, so the *prima facie* cases for obviousness must fail. The Assignee thus respectfully asserts that the § 103 (a) rejection of the claims should be removed.

3. The Proposed Combinations Do Not Teach or Suggest All the Features of the Independent Claims, so the § 103 (a) Rejections are Improper

Claims 3-10 and 12-16 are not obvious. These claims all recite, or incorporate, features that are not taught or suggested by *Nakai* in view of various combinations of *Hylton '961*, *Rowe*, *Hylton '413*, and *D'Luna*. The proposed combinations are all completely silent to "a broadband input/output module receiving the transport layer from the system bus and sending the transport layer to a network bus." The proposed combinations are further silent to a "network input/output

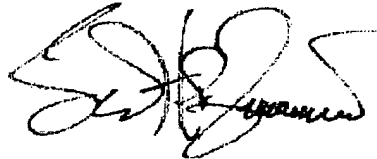
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module receiving the transport layer from the network bus." Because these cited documents fail to teach or suggest all the features of the claims, one of ordinary skill in the art would not think that the claims are obvious. The Office is, therefore, required to remove the § 103 rejections.

If any questions arise, the Office is requested to contact the undersigned at (919) 387-6907 or scott@wzpatents.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Scott P. Zimmerman", with a stylized flourish at the end.

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